

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-10 and 16-20 are currently pending. Claims 1 and 6 having been amended; Claims 11-15 having been canceled without prejudice or disclaimer; and Claims 16-20 having been added by the present Amendment. Support for amended Claims 1 and 6 and new Claims 16-20 can be found, for example, in the original claims, drawings, and specification as originally filed.<sup>1</sup> No new matter has been added.

In the outstanding Office Actions, Claims 1, 2, 4-7, 9 and 10 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication 2006/0001912 to Miyashita; and Claims 3 and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over Miyashita in view of U.S. Patent Application Publication No. 2003/0161468 to Iwagaki et al. (hereinafter "Iwagaki").

Applicant acknowledges with appreciation the courtesy of Examiner Thompson in granting an interview in this case with Applicant's representatives on November 30, 2010, during which time the issues in the outstanding Office Action were discussed as substantially summarized hereinafter and also on the Interview Summary Sheet. No agreement was reached during the interview pending a formal response to the outstanding Office Action.

In response to the rejections under 35 U.S. C. §§ 102(e) and 103(a), Applicant respectfully submits that independent Claims 1 and 6 recite features clearly not taught or rendered obvious by Miyashita and Iwagaki.

Independent Claim 1 is directed to a data editing system including, *inter alia*:

...decoding means for decoding encoded material data  
into decoded material data while extracting additional  
information from said encoded material data and extracting

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<sup>1</sup> See, for example, Figures 2, 9A and 10; and page 20; lines 14-17; page 21, lines 21-24; page 55, lines 2-5; and page 56, lines 10-15 of the specification.

unique information from the extracted additional information in order to output a signal constituted by said decoded material data supplemented with said unique information;

***database means for storing into an electronic database*** said unique information in correspondence with predetermined processing parameter information, ***the processing parameter information indicating one or more editing processes performed on said decoded material data supplemented with said unique information;*** and

editing means for performing predetermined editing on said signal output by said decoding means while acquiring from said database means the processing parameter information corresponding to said unique information, ***said editing performed in accordance with said processing parameter information.***

Miyashita describes a copying machine which embeds history information within image data.<sup>2</sup> The copy machine reads an original image, converts the image to a digital image, extracts history information embedded in the digital image, adds history information including a machine number of the copy machine to the history information, embeds the updated history information in the image data, and outputs the image data to an image forming section of the copy machine.<sup>3</sup>

Regarding the rejection of Claim 1 under 35 U.S.C. § 102(e), page 3 of the Office Action asserts that a “history information database,” according to Miyashita is analogous to the claimed database means. However, Miyashita fails to include any reference to a database. During the interview, the Examiner asserted that a printed sheet including embedded history information in an image is the “history information database,” referred to in the Office Action.

However, Claim 1 is written in means-plus-function format. MPEP 2181 states that:

When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a "means or step plus function" limitation by giving it the "broadest reasonable interpretation." Under the PTO's long-standing practice this

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<sup>2</sup> See the Abstract of Miyashita.

<sup>3</sup> See paragraph 40 of Miyashita.

meant interpreting such a limitation as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in *Donaldson*, the Federal Circuit stated:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, ***the PTO may not disregard the structure disclosed in the specification*** corresponding to such language when rendering a patentability determination.

Without conceding that such an interpretation of the teachings of Miyashita is reasonable, a sheet of paper as used in Miyashita is certainly not analogous to the structure of a database means, as supported by the Applicant's specification. In the non-limiting embodiment illustrated in Figures 3 and 9A, and the non-limiting description at page 23, lines 19-23 of the Applicant's specification, an exemplary database is an electronic apparatus capable of performing a search (or being searched) and returning results of the search. A sheet of paper as described in Miyashita fails to have these capabilities. Claim 1 has been amended to recite a "database means for storing an ***electronic*** database" to emphasize this point.

Further, the database means of Claim 1 stores "unique information in correspondence with predetermined processing parameter information." This processing parameter information is then used by the editing means. Thus, the database must store a unique identifier and processing parameter information used for editing associated with the unique identifier. To this point, Applicant has amended Claim 1 to recite that the editing performed by the editing means is "performed in accordance with said processing parameter."

The Office Action apparently asserts that extracted embedded history information is analogous to the claimed decoded material data and that write position flags are analogous to processing parameter information.

However, write position flags, according to Miyashita, are only used to determine which record number history information should be added to. As shown in Miyashita's Figure 7, a write position flag is turned on one position beyond a currently set flag (or at the first position is the currently set flag is in a last position), and the currently set flag is turned off. Thus, write position flags fail to include any information related to "editing processes *performed* on said decoded material data," as recited in Claim 1.

Thus, Miyashita fails to teach at least the claimed database means and the claimed processing parameter information stored in the claimed database means and used by the claimed editing means to perform editing in accordance with the processing parameter information.

Accordingly, Applicant respectfully submits that Miyashita fails to anticipate amended Claim 1.

Regarding the rejection of amended independent Claim 6 under 35 U.S.C. § 102(e), Claim 6 recites "storing into an *electronic* database said unique information in correspondence with predetermined processing parameter information," and that "the processing parameter information indicating *editing processing performed on said decoded material data*."

Thus, Miyashita fails to anticipate amended Claim 6 at least for reasons analogous to those presented above with respect to Claim 1.

Accordingly, Applicant respectfully submits that independent Claims 1 and 6, and all similarly rejected dependent claims, patentably define over Miyashita.

Applicant respectfully submits that Claim 2 is further patentable, as Claim 2 recites "encoding means for encoding said signal *edited by said editing means*." In the rejection of Claim 1, and as noted above, the Office Action apparently asserts that processing parameter information is analogous to a write position flag. Page 3 of the Office Action asserts that this

flag is used to time-sort history information. Although it is unclear how such a sorting could be done based on a flag which is set on only one entry, paragraph [0045] of Miyashita states that “the records of the extracted history information are time-serially sorted on the basis of the write position flag states,” and that “the sorted records of history information are *displayed*.”

Thus, even if such a time sorting operation were analogous to processing parameter information used in editing, it still fails to teach the features of Claim 2 as the time sorted records are merely *displayed*. Miyashita fails to disclose *encoding* “said signal *edited* by said editing means,” where the editing means edits the signal in accordance with processing parameter information stored in the database means, as recited in Claim 2.

Dependent Claim 7 recites similar features to those of Claim 2 with dependency from independent Claim 6. Thus, Applicant respectfully submits that dependent Claim 7 is further patentable at least for reasons analogous to those presented with respect to Claim 2.

Regarding Claims 3 and 8 rejected under 35 U.S.C. § 103(a) as obvious over Miyashita in view of Iwagaki, Applicant notes that Claims 3 and 8 are dependent on Claims 1 and 6, and are believed to be patentable at least for the reasons described above. Further, Applicant respectfully submits that Iwagaki fails to cure any of the above noted deficiencies of Miyashita.

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. §§ 102(e) and 103(a) be withdrawn.

Additionally, Applicant respectfully submits that no proper combination of Miyashita and Iwagaki teaches or renders obvious the subject matter of new Claims 16-20.

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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